

REMARKS

Applicants have amended claims 1-10, 12-18, 20-23, and 25-29, and have cancelled claims 10-11, 19, and 24, during prosecution of this patent application. Applicants are not conceding in this patent application that the subject matter encompassed by said amended and cancelled claims are not patentable over the art cited by the Examiner, since the claim amendments and cancellations are only for facilitating expeditious prosecution of this patent application. Applicants respectfully reserve the right to pursue the subject matter encompassed by said amended and cancelled claims, and to pursue other claims, in one or more continuations and/or divisional patent applications.

The Examiner rejected claim 29 under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter.

The Examiner rejected claims 1-10, 12-18, 20-23 and 25-29 on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-19 of U.S. Patent No. 6,940,491 in view of US patent application publication 2004/0021648 (Blume).

The Examiner rejected claims 1-10, 12-18, 20-23 and 25-29 under 35 U.S.C. § 103(a) as allegedly being unpatentable over US Patent Application Publication 2002/0152236 (Incertis-Carro, hereinafter Carro), in view of US Patent Application Publication 2004/0021648 (Blume), further in view of US Patent 6,115,482 (Sears).

Applicants respectfully traverse the § 101, double patenting and § 103 rejections with the following arguments.

35 U.S.C. § 101: Claim 29

The Examiner rejected claim 29 under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter.

The Examiner argues: "Claim 29 directs to software per se ("A computer program"). Software per se is non-statutory subject matter."

In response, Applicants note that the amended claim 29 is not directed to software per se. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 29 under 35 U.S.C. § 101.

Double Patenting Rejection: Claims 1-10, 12-18, 20-23 and 25-29

The Examiner rejected claims 1-10, 12-18, 20-23 and 25-29 on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-19 of U.S. Patent No. 6,940,491 in view of US patent application publication 2004/0021648 (Blume).

Since claim 10 has been cancelled, the rejection of claim 10 on the ground of non-statutory obviousness-type double patenting is moot.

The Examiner argues: “Claims 1-10, 12-18, 20-23, 25-29 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,940,491 in view of US patent application publication 2004/0021648 (Blume). Presenting the retrieved data visually or audibly to visual impaired person would have been obvious in view of Blume (see par 0051).”

In response, Applicants respectfully contend that claim 1 of the present patent application is not unpatentable over claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume, because claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume does not teach or suggest each and every feature of claim 1 of the present patent application.

A first example of why claim 1 of the present patent application is not unpatentable over claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume is that claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume does not teach or suggest the feature:

“identifying an existing physical document;

after said identifying the existing physical document, identifying and locating an electronic copy of said identified existing physical document, wherein the electronic copy of the document is an *exact replica* of the physical document" (emphasis added).

Claim 1 of U.S. Patent No. 6,940,491 recites: "selecting an electronic document (203); creating (802) an hyperlink table (201); associating (802) said hyperlink table with a physical copy (202) of said electronic document".

However, the preceding quote from claim 1 of U.S. Patent No. 6,940,491 does not disclose that the electronic document is identified *after* the existing physical copy of the electronic document is identified.

Therefore, claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume does not disclose the preceding feature of claim 1 of the present patent application.

In addition, the preceding quote from claim 1 of U.S. Patent No. 6,940,491 does not disclose that the electronic document is an *exact replica* of the physical copy of the electronic document.

Therefore, claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume does not disclose the preceding feature of claim 1 of the present patent application.

A second example of why claim 1 of the present patent application is not unpatentable over claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume is that claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume does not teach or suggest the feature:

"identifying an existing physical document;

after said identifying the existing physical document, identifying and locating an electronic copy of said identified existing physical document, wherein the electronic copy of the document is an exact replica of the physical document;

identifying one page or a plurality of pages of said physical document;

identifying a selected part of the physical document using the position of points on said identified one page or a plurality of pages;

in response to said identifying the selected part of the physical document using the position of points on said identified one page or a plurality of pages, retrieving, from the electronic copy of the physical document, data related to the selected part of the physical document”.

More specifically, claims 1-19 of U.S. Patent No. 6,940,491 do not disclose: retrieving, from the electronic copy of the physical document that is an exact replica of the physical document, data related to the selected part of the physical document, wherein said retrieving is performed in response to said identifying the selected part of the physical document.

Applicants note that claim 14 of U.S. Patent No. 6,940,491 recites: “accessing the information or service associated with the selected hyperlinked item”. However, claim 14 of U.S. Patent No. 6,940,491 does not disclose that the information associated with the hyperlinked item is being accessed from an the electronic copy of the physical document that is an exact replica of the physical document.

Instead, claim 14 of U.S. Patent No. 6,940,491 discloses that the information (associated with the hyperlinked item) that is accessed is identified and located *via referral to a hyperlink table* that comprises the information associated with the hyperlinked item. Specifically, claim 14

of U.S. Patent No. 6,940,491 recites: “identifying and locating information and/or service associated with the selected hyperlinked item *referring to the hyperlink table*, said hyperlink table comprising for each hyperlinked item of each page of the document the identification and location of the information and/or service associated with the hyperlinked item” (emphasis added).

Therefore, claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume does not disclose the preceding feature of claim 1 of the present patent application.

In addition, Applicants note that claim 1 of U.S. Patent No. 6,940,491 recites: “for each page of the physical copy:

identifying (803) in the electronic document, the one or plurality of hyperlink items comprised in the page; ...

retrieving (803) from the electronic document identification and location of information and/or service associated with each identified hyperlink item on the page; ...

retrieving (805) from the electronic document, electronic coordinates of each identified hyperlinked item on the page; translating (805) said electronic coordinates into physical coordinates on the page of the physical copy”.

Although, claim 1 of U.S. Patent No. 6,940,491 recites “identifying (803) in the electronic document, the one or plurality of hyperlink items comprised in the page”, claim 1 of U.S. Patent No. 6,940,491 does not disclose that the position of points on the selected page or pages are used to identify the one or plurality of hyperlink items.

Therefore, claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume does not disclose the preceding feature of claim 1 of the present patent application.

Although, claim 1 of U.S. Patent No. 6,940,491 recites “retrieving (803) from the electronic document identification and location of information and/or service associated with each identified hyperlink item on the page”, claim 1 of U.S. Patent No. 6,940,491 does not disclose that information and/or service associated with each identified hyperlink item on the page is retrieved “in response to said identifying the selected part of the physical document using the position of points on said identified one page or a plurality of pages” at least because claim 1 of U.S. Patent No. 6,940,491 does not disclose “identifying a selected part of the physical document using the position of points on said identified one page or a plurality of pages” as explained *supra*.

Therefore, claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume does not disclose the preceding feature of claim 1 of the present patent application.

A third example of why claim 1 of the present patent application is not unpatentable over claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume is that claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume does not teach or suggest the feature: “*presenting said retrieved data visually to a visually impaired person* or orally to a blind person on the user system, wherein said presenting said retrieved data visually is configured to enable the visually impaired person to see said retrieved data, and wherein said presenting said retrieved data orally is configured to enable the blind person to hear said retrieved data” (emphasis added).

The Examiner argues: “Presenting the retrieved data visually or audibly to visual impaired person would have been obvious in view of Blume (see par 0051)”.

In response, Applicants note that Blume, Par. [0051] recites: “This system ... can ... provide *speaking books* for the visually impaired” (emphasis added), which is not a disclosure of

“presenting said retrieved data visually to a visually impaired person”, which demonstrates that Blume does not disclose the preceding feature of claim 1 of the present patent application..

In further response, Applicants note that the Examiner acknowledges on page 5 of the office action that “Blume fails to clearly address presenting the retrieved data visually to a visually impaired person”, which further demonstrates that Blume does not disclose the preceding feature of claim 1 of the present patent application.

Therefore, claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume does not disclose the preceding feature of claim 1 of the present patent application.

Based on the preceding arguments, Applicants respectfully maintain that claim 1 of the present patent application is not unpatentable over claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume. Since claims 2-9, 12-18, 20-23 and 25-29 of the present patent application depend from claim 1 of the present patent application, Applicants respectfully maintain that claims 2-9, 12-18, 20-23 and 25-29 of the present patent application are likewise not unpatentable over claims 1-19 of U.S. Patent No. 6,940,491 in view of Blume.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-9, 12-18, 20-23 and 25-29 on the ground of non-statutory obviousness-type double patenting.

35 U.S.C. § 103(a): Claims 1-10, 12-18, 20-23, 25-29

The Examiner rejected claims 1-10, 12-18, 20-23 and 25-29 under 35 U.S.C. § 103(a) as allegedly being unpatentable over US Patent Application Publication 2002/0152236 (Incertis-Carro, hereinafter Carro), in view of US Patent Application Publication 2004/0021648 (Blume), further in view of US Patent 6,115,482 (Sears).

Since claim 10 has been cancelled, the rejection of claim 10 under 35 U.S.C. § 103(a) is moot.

Applicants respectfully contend that claim 1 is not unpatentable over Carro in view of Blume, and further in view of Sears, because Carro in view of Blume, and further in view of Sears does not teach or suggest each and every feature of claim 1.

A first example of why claim 1 is not unpatentable over Carro in view of Blume, and further in view of Sears is that Carro in view of Blume, and further in view of Sears does not teach or suggest the feature:

“identifying an existing physical document;
after said identifying the existing physical document, identifying and locating an electronic copy of said identified existing physical document, wherein the electronic copy of the document is an *exact replica* of the physical document”.

The Examiner argues: “Carro teaches ... Identifying a physical document (0097, 0109, 0135, 0173, 0175), ... Identifying and locating an electronic copy of said identified document (0122, 0124, 0128, 0173, 0175).”

In response, Applicants acknowledge that the preceding citations to Carro by the Examiner disclose a physical copy of an electronic document (i.e., Caro, Pars. [0122], [0128], [0135], [0173], [0175]). However, Carro does not disclose that the electronic document is identified *after* the existing physical copy of the electronic document is identified.

In fact, Carro, FIG. 8 shows that the physical copy of the electronic document is generated in step 807, which demonstrates that the physical copy of the electronic document does not exist before being generated in step 807. However, steps 803 and 805 in Carro, FIG. 8 comprises retrieving data from the electronic document, which demonstrates that the electronic document has been identified when steps 803 and 805 are performed. Since steps 803 and 805 are performed before step 807 is performed, Applicants assert that Carro, FIG. 8 demonstrates that Carro discloses that the electronic document is identified *before* the physical copy of the electronic document exists and thus *before* the existing physical copy of the electronic document is identified.

Therefore, Carro in view of Blume, and further in view of Sears does not disclose the preceding feature of claim 1.

In addition, Carro does not disclose that the electronic document is an *exact replica* of the physical copy of the electronic document.

Therefore, Carro in view of Blume, and further in view of Sears does not disclose the preceding feature of claim 1.

A second example of why claim 1 is not unpatentable over Carro in view of Blume, and further in view of Sears is that Carro in view of Blume, and further in view of Sears does not teach or suggest the feature:

“identifying an existing physical document;

after said identifying the existing physical document, identifying and locating an electronic copy of said identified existing physical document, *wherein the electronic copy of the document is an exact replica of the physical document*;

identifying one page or a plurality of pages of said physical document;

identifying a selected part of the physical document using the position of points on said identified one page or a plurality of pages;

in response to said identifying the selected part of the physical document using the position of points on said identified one page or a plurality of pages, *retrieving, from the electronic copy of the physical document, data related to the selected part of the physical document*”. (emphasis added)

More specifically, Carro in view of Blume, and further in view of Sears does not disclose: retrieving, from the electronic copy of the physical document that is an exact replica of the physical document, data related to the selected part of the physical document.

The Examiner argues: “Carro teaches ... retrieving from the electronic copy of the physical document, data related to the selected part of the document (0110, 0111, 0178)”

In response, Applicants note that Carro, Par. [0110] recites: “Illuminated items are selected by pressing the opto-touch foil. When the user selects an item (307) among all illuminated items (302), the user workstation (300) receives from the opto-touch foil (304) a

signal indicating the position of this selected item on the physical document (303). The user workstation identifies and locates *referring to a hyperlink table* (308) the information and/or the service associated with the position of the selected item (307). If the information and/or service is located in a remote server (306), a request is sent to this server. If the information and/or the service is stored in the user workstation (300), then this information and/or service is accessed locally.” (emphasis added)

Applicants respectfully contend that the preceding quote from Carro, Par. [0110] does not disclose that the information associated with the hyperlinked item is being accessed from an the electronic copy of the physical document that is an exact replica of the physical document. Instead, the preceding quote from Carro, Par. [0110] discloses that the information (associated with the hyperlinked item) that is accessed is identified and located via *referral to a hyperlink table* that comprises the information associated with the hyperlinked item.

Therefore, Carro in view of Blume, and further in view of Sears does not disclose the preceding feature of claim 1.

Based on the preceding arguments, Applicants respectfully maintain that claim 1 is not unpatentable over Carro in view of Blume, further in view of Sears, and that claim 1 is in condition for allowance. Since claims 2-9, 12-18, 20-23 and 25-29 depend from claim 1, Applicants contend that claims 2-9, 12-18, 20-23 and 25-29 are likewise in condition for allowance.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invite the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457 (IBM). The Attorney's reference number for this case is END-8841.

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